

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/092,489 06/05/98 LEIFER

A 0079/55346-A

QM12/0508

KEUSEY & TUTUNJIAN
14 VANDERVENTER AVENUE, LS
PORT WASHINGTON NY 11050

EXAMINER

HARRISON, T

ART UNIT PAPER NUMBER

3713

12

DATE MAILED:

05/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/092,489	Applicant(s) Leifer et al.
	Examiner J. Harrison	Group Art Unit 3713

Responsive to communication(s) filed on Feb 15, 2000.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-54 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-54 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3713

DETAILED ACTION

Priority

This application is a continuation-in-part of application Serial No. 09/023813, filed February 13, 1998.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 10, 12, 19, 23-25, and 27-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5, 10, 12, 19, 25, 34, 41, 47 and 53, each of these claims attempts to further define a particular object found in the video game. However, no combination of the controller system and game software is seen claimed. The independent claims from which these claims depend refer to an object in a game as part of the function accomplished by the modify signal received by the receiver. Even if a combination were properly claimed, it is not seen how this language would be further limiting to the controller structure - the fact that information is passed from the interface on to a game console is important, not what the game console does with

Art Unit: 3713

that information. It is not seen how the claims, as currently presented, could further limit the object in the game to be, for example a weapon and further, it is not seen how properly defining such would be salient to applicants invention. Applicant should consider defining the “rapid fire” or “autofire” feature in terms of a more generic repetition of the signal and stay focused on what transpires between the controller and the interface in relation to the game console.

Regarding claims 23 and 24, there is a lack of antecedent basis for “the peripheral device”. Perhaps dependency from claim 22 was intended.

Regarding claims 40, 46 and 52, these claims each recite a “video output device connectable...”. First, it is not clear if the output device claimed is the outputting device 14 disclosed (note there is a difference in scope between output and outputting), and secondly it is not clear if there is any connection to the system as ‘connectable’ sets forth a possibility rather than an absolute. Without a connection, this devices relation to the invention is unclear.

Regarding claim 27 and those dependent thereon, there is a disagreement in number with respect to the elements. A plurality of controllers are defined, each transmitting and receiving information, yet the at least one console interface only receives information from “the controller”(singular). Clarification is necessary. Further note that if claim 27 is modified such that the receiver in the interface does receive information from a plurality of controllers, then claims 38 and 39 will require modification as claim 38 will fail to further limit claim 27.

Finally, regarding claims 35, 42 and 48, the examiner questions the language “a game console” in each of these claims. While applicant may claim his invention in combination with

Art Unit: 3713

other known elements, it is not clear why the console is recited. Once a connection from the interface is established (again note the use of connectable in these claims), the claim remains referential in its recitation of the game console and the console's role with respect to the invention is not clear. Perhaps applicant intends to claim use of his invention with a game console?

It is suggested applicant review all claims presented in addition to those noted hereinabove to ensure each claims is clear and definite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4, 5, 11, 12, 20, 27, 34, 35, 40, 41, 48, 52 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodenmann et al. (Bod). Bod discloses a method and apparatus for establishing a standardized communications protocol for wireless communications between a host and one or more peripheral devices. The host may be a game console, and the peripheral devices may be game pads, as in the claimed invention. Each peripheral device includes a switch and a transmitter operating at a predefined frequency. The system includes a receiver unit, connected to the host, for receiving the data, decoding, and processing as necessary. The

Art Unit: 3713

peripheral device may also include a receiver along with the receiver unit including a transmitter, such that bi-directional communications are possible. Inherently, if the host device is a video game console, there is a video output(ting) device. The Bod patent also discusses the well known “autofire” feature present in game controllers, and provides a particular implementation for such in his wireless system. Note 9:35 -42, and particularly “To minimize power consumption, the autofire function or other similar continuous-on functions are preferably maintained by the host receiver, since this minimizes power consumption at the remote device”. Clearly the Bod patent includes autofire features and they are maintained in the receiver. Further, inherently such would be used in playing game software that supported autofire features, such as one where the game object was a weapon which required repeated fast activation. Accordingly, the reference is deemed to anticipate the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 8-10, 13, 15, 17-19, 21-25, 28-32, 38, 39, 42, 44-47, 49, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodenmann et al. (Bod) in view of Takeda et al (Tak).

Art Unit: 3713

Bod has been discussed above. The difference between the instant claims and the teachings of Bod lie in the particular housing claimed, the provision of a peripheral device in the controller, as well as a memory cartridge for storing game related information in the receiver unit, and the provision of a plurality of such controllers and receiver units for multi player action.

Tak discloses a conventional controller for the NES system having the exact housing structure claimed, and including peripheral units such as a memory unit attached to the back of the housing. This memory unit, or expansion cartridge, is for storing game related data - see 11:20-55. Official notice is taken that in addition to memory units, vibrating units such as the NES Rumble Pak were well known at the time of the invention. These units, with or without memory, insert into the same expansion slot and provide vibration to the user's hands in response to game action. Further, noting Tak at col 11:60 - 12:12, Tak teaches the advantages of providing the memory unit on the controller over providing the slots on the game machine unit.

Wireless game controllers are known in the art, as admitted by applicant and discussed in Bod. In looking to provide a wireless controller for a NES system, one of ordinary skill in the art would consider Tak, and modify the game pads of Bod to have the housing of Tak. Further, in providing such a wireless controller, one of ordinary skill in the art would consider the power requirements of the wireless controller, as such must be powered by batteries. Provision of the memory cartridge in the controller housing would consume power - leading one to look for a different arrangement. Given that Bod suggests provision of the autofire feature in the receiver unit to reduce power consumption at the controller, and Tak teaches away from providing the

Art Unit: 3713

memory unit at the game console, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the memory unit of Tak in the receiver units of Bod, in order to provide the desirable features known to a NES controller in a wireless format while maintaining reasonable power consumption in the wireless units. Doing such would leave the expansion slot available on the controller unit for other peripherals such as a vibration pack. Further, it would have been obvious to provide multiple receiver units as necessary, in order to provide for multi player action and each player having a memory unit available to him.

Claims 3, 7, 14, 16, 26, 33, 36, 37, 43 and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Bodenmann et al (Bod) alone or Bodenmann et al (Bod) in view of Takeda et al (Tak) respectively, as applied to claims listed above, and further in view of Khoury.

The difference between these claims and the Bod reference, or the Bod in view of Tak combination, lie in the provision of a “sleep” feature to the controller system. While Figure 2 of Bod does have a block labeled Sleep, Bod appears silent with respect to this element/feature.

As admitted by applicant, the provision of a sleep feature in game controllers both wired and wireless is known. Khoury has been cited in support of this position - for his discussion in the background as well as for his general teaching of conserving power in a controller by the addition of a sleep or power down feature in a game controller. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the wireless controller of

Art Unit: 3713

Bod (as modified above) to further incorporate a sleep feature in order to conserve power upon switch inactivity.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Harrison whose telephone number is (703) 308-2217.



JESSICA J. HARRISON
PRIMARY EXAMINER

jjh

April 25, 2000